

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Atty BJS-4984-4  
Dkt.

C# M#

**Attachment:****REQUEST FOR A NEW OFFICE  
ACTION PURSUANT TO MPEP  
§§ 706.07(h) AND 706.07(b)**

SVANBORG, C. et al.

TC/A.U. 1656

Serial No. 10/506,903

Examiner: Rooke

Filed: December 8, 2004

Date: June 10, 2008

Title: BIOLOGICALLY ACTIVE COMPLEX

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RESPONSE/AMENDMENT/LETTER**

This is a response/amendment/letter in the above-identified application and includes an attachment which is hereby incorporated by reference and the signature below serves as the signature to the attachment in the absence of any other signature thereon.

☐ **Correspondence Address Indication Form Attached.****Fees are attached as calculated below:**

|  |                    |                      |                                |
|--|--------------------|----------------------|--------------------------------|
| Total effective claims after amendment | 0                  | minus highest number |                                |
| previously paid for                    | 20 (at least 20) = | 0 x \$50.00          | \$0.00 (1202)/\$0.00 (2202) \$ |

|                                    |                  |                      |                                |
|------------------------------------|------------------|----------------------|--------------------------------|
| Independent claims after amendment | 0                | minus highest number |                                |
| previously paid for                | 3 (at least 3) = | 0 x \$210.00         | \$0.00 (1201)/\$0.00 (2201) \$ |

|  |  |                               |    |
|--|--|-------------------------------|----|
| If proper multiple dependent claims now added for first time, (ignore improper); add |  |                               |    |
|  |  | \$370.00 (1203)/\$0.00 (2203) | \$ |

|   |  |  |    |
|---|--|--|----|
| Petition is hereby made to extend the current due date so as to cover the filing date of this |  |  |    |
| paper and attachment(s)   |  | One Month Extension \$120.00 (1251)/\$0.00 (2251)        |    |
|   |  | Two Month Extensions \$460.00 (1252)/\$0.00 (2252)       |    |
|   |  | Three Month Extensions \$1050.00 (1253)/\$0.00 (2253)    |    |
|   |  | Four Month Extensions \$1640.00 (1254)/\$0.00 (2254)     |    |
|   |  | Five Month Extensions \$2,230.00 (1255)/\$1115.00 (2255) | \$ |
|   |  | \$130.00 (1814)/ \$0.00 (2814)                           | \$ |

Terminal disclaimer enclosed, add

☐ Applicant claims "small entity" status. ☐ Statement filed herewith

|   |                 |    |      |
|---|-----------------|----|------|
| Rule 56 Information Disclosure Statement Filing Fee | \$180.00 (1806) | \$ | 0.00 |
|---|-----------------|----|------|

|                          |                |    |      |
|--------------------------|----------------|----|------|
| Assignment Recording Fee | \$40.00 (8021) | \$ | 0.00 |
|--------------------------|----------------|----|------|

|        |  |    |      |
|--------|--|----|------|
| Other: |  | \$ | 0.00 |
|--------|--|----|------|

|                  |           |             |
|------------------|-----------|-------------|
| <b>TOTAL FEE</b> | <b>\$</b> | <b>0.00</b> |
|------------------|-----------|-------------|

☐ **CREDIT CARD PAYMENT FORM ATTACHED.**

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140. A duplicate copy of this sheet is attached.

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BJS:ppNIXON & VANDERHYE P.C.  
By Atty: B. J. Sadoff, Reg. No. 36,663

Signature: \_\_\_\_\_/B. J. Sadoff/

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of

SVANBORG, C. et al.

Atty. Ref.: 4984-4; Confirmation No. 7669

Appl. No. 10/506,903

TC/A.U. 1656

Filed: December 8, 2004

Examiner: Rooke

For: BIOLOGICALLY ACTIVE COMPLEX

\* \* \* \* \*

June 10, 2008

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**REQUEST FOR A NEW OFFICE ACTION PURSUANT TO MPEP §§ 706.07(h) AND  
706.07(b)**

The Advisory Action of April 23, 2008 refused entry of the Amendment filed April 14, 2008 because the Examiner asserted that the Amendment raises new issues that would require further consideration and/or search.

The applicants filed a RCE April 25, 2008 requesting entry and consideration of the Amendment of April 14, 2008.

The Examiner has made the first Action after the filing of the RCE, i.e., an Office Action mailed May 28, 2008, a final rejection.

The applicants submit, with due respect, that the finality of the Office action dated May 28, 2008 is premature. The Examiner is requested to vacate the Office Action of

May 28, 2008 and mail a new non-final Office Action, with the date re-set for responding from the mail date of the further non-final Office Action.

The Examiner is urged to appreciate that issuance of the first Action final rejection after the filing of a RCE is contrary to the MPEP and hence improper.

Specifically, MPEP §§ 706.07(h) and 706.07(b) provide as follows:

706.07(h) Request for Continued Examination (RCE)  
Practice

#### VIII. FIRST ACTION FINAL AFTER FILING AN RCE

The action immediately subsequent to the filing of an RCE with a submission and fee under 37 CFR 1.114 may be made final only if the conditions set forth in MPEP § 706.07(b) for making a first action final in a continuing application are met. See [http://www.uspto.gov/web/offices/pac/mpep/documents/0700\\_706\\_07\\_h.htm](http://www.uspto.gov/web/offices/pac/mpep/documents/0700_706_07_h.htm) (July 15, 2007).

#### 706.07(b) Final Rejection, When Proper on First Action

However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised. See [http://www.uspto.gov/web/offices/pac/mpep/documents/0700\\_706\\_07\\_b.htm#sect706.07b](http://www.uspto.gov/web/offices/pac/mpep/documents/0700_706_07_b.htm#sect706.07b) (July 15, 2007) (Emphasis added).

The undersigned telephoned the Examiner and left a voice mail message on June 9, 2008 making the above request.

An early and favorable non-final Action on the merits is requested.

SVANBORG, C. et al.

Appl. No. 10/506,903

Atty. Ref.: 4984-4

June 10, 2008

REQUEST FOR A NEW OFFICE ACTION PURSUANT TO MPEP §§ 706.07(h) AND  
706.07(b)

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

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